UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,679	03/30/2000	Greg Linden	249768021US	8745

25096 7590 05/19/2006

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER	
MCALLISTER, STEVEN B	
ART UNIT	**PAPER NUMBER**
3627	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/538,679
Filing Date: March 30, 2000
Appellant(s): LINDEN, GREG

Steven D. Lawrenz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 5, 2005 appealing from the Office action mailed June 14, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Website printout of Philips Compandor SA571,

http://www.kwantlen.bc.ca/electronics/eltn2319/edata/lab/datasheets/compandor571.html, 1998.

6,212,517	SATO et al	4-2001
5,848,407	ISHIKAWA et al	12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

Claim 1 is objected to as based on a disclosure which is not enabling. Assuming that same is being given its established meaning of identical, that the description of the distinguished item and description of the item identified as the same auction fully describe every relevant aspect of their products is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Since the method is being called upon to identify an auction for the same item, all aspects of the item must be described. For instance, any description of a bolt might need at least diameter, length, thread, head type, material, coating, etc. If descriptions contained a subset of these aspects, even an apparent perfect correspondence might show dissimilar bolts, for instance bolts with dissimilar lengths or bolts with different thread types.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "identifying as an auction offering an item unit that is a unit of the same item as the first unit". Assuming that the claim relies on the established definition of "same" meaning identical, the claim method cannot identify that the item is the same as the one identified. Rather it can only identify an item having a description where the sum of the inverse document frequencies of the selected terms exceeds a threshold. It can only predict similarity based on keywords.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Alternatively, assuming that "same" is not meant to mean identical as discussed above, and the term "same" in claim 1 is used by the claim to mean "similar or the same," while the accepted meaning is "resembling in every relevant respect; conforming in every respect; being one without addition, change, or discontinuance: identical" [*Merriam Webster's Collegiate Dictionary, 10th ed.*].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-36, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Philips Semiconductors webpage in view of Ishikawa et al (5,848,407) and Sato et al (6,212,517).

Assuming that "same" means "essentially Athe same or similar" as argued by the Applicant, Philips shows displaying information about a first sale item including a

description; and receiving user input requesting user input for similar items, comprising receiving input from the "Find Similar Items" button or receiving input from one of the links listed below the "Find Similar Items" heading.

Philips does not show the claimed method for determining similar items. Sato et al show determining for the specified text, the IDF of terms occurring in the text (see e.g., col. 6, lines 1-17) and selecting a plurality of search terms having the largest IDFs and searching the selected keywords (see e.g., col. 7, lines 27-30; Fig. 8). It would have been obvious to one of ordinary skill in the art to modify the method of Philips by performing the steps of Sato et al in order to provide a search tool which provides a measure of item similarity without requiring additional customer input or manual searching through documents.

Philips further does not show determining which of the terms is in the found item's description and identifying a similar auction where the sum of the IDFs determine the similarity; or displaying information about the item. Ishikawa et al show these steps (see e.g., col. 7, line 53 to col. 8, line 9; col. 11, lines 33-45). It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by determining similar documents by adding the IDFs for the terms in order to provide a simple and efficient means of determining similarity.

Finally, Philips does not show sales of items via auction. However, it is notoriously old and well known in the art to sell items via online auction. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by auctioning items in order to get the highest price.

As to claim 56, Philips in view of Ishikawa et al and Sato et al show displaying information about at least a portion of the found documents.

As to claim 57, Philips in view of Ishikawa et al and Sato et al inherently show comparing the IDF of each term in the description to a minimum threshold comprising the nth lowest IDF where n terms are used as keywords (it is noted that the threshold is not recited as fixed).

As to claim 2, Philips shows a purchasing opportunity at a store displaying information about a first sale item including a description. Philips does not show the specific search method.

Sato et al show determining for the specified text, the IDF of terms occurring in the text (see e.g., col. 6, lines 1-17) and selecting a plurality of search terms having the largest IDFs (see e.g., col. 7, lines 27-30; Fig. 8). It would have been obvious to one of ordinary skill in the art to modify the method of Philips by performing the steps of Sato et al in order to provide a search tool which provides a measure of item similarity without requiring additional customer input.

Philips further does not show performing the search; establishing a score based on summing the term scores of the key words; or displaying information about one or more results. Ishikawa et al show these steps (see e.g., col. 7, line 53 to col. 8, line 9; col. 11, lines 33-45). It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by finding and scoring similar documents by adding

the IDFs for the terms in order to provide a simple and efficient means of determining similarity

As to claim 7, it is noted that Philips shows selecting the purchasing opportunities in response to a request from the user.

As to claims 8 and 9, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except selecting the distinguished purchasing opportunity in response to purchase of an item offered therein. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by selecting the opportunity in response to a purchase in order to provide information to the buyer about the purchased item.

As to claims 8 and 10, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except selecting the distinguished purchasing opportunity in response to placing of a bid. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by selecting the opportunity in response to a bid in order to provide information to the buyer about the item.

As to claim 11, it is noted that Philips in view of Sato et al and Ishikawa et al show displaying the purchasing opportunity with the highest score.

As to claim 12, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except showing the similar purchasing opportunity in response to a request for information about the distinguished purchasing opportunity. However, it is notoriously old and well known in the art to show a similar item along with the item

requested. It would have been obvious to one of ordinary skill in the art to do so in order to present more purchasing opportunities to the buyer and therefore increase the chances of his making a purchase.

As to claim 13, all elements of the claim are shown except listing the purchasing opportunities in order of their scores. However, it is notoriously old and well known in the art to list search results in descending order of relevance or similarity. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by doing so in order to present the most likely purchase opportunities first.

As to claims 14 and 16, it is noted that Philips in view of Sato et al and Ishikawa et al show all elements except displaying a subset of the opportunities. However, it is notoriously old and well known to display a proper subset of the search results. It would have been obvious to one of ordinary skill in the art to display only a subset in order to fit the information on a standard computer screen with a legible type size.

As to claims 14 and 15, Philips in view of Ishikawa et al and Sato et al show all elements of the claims except showing a number of the subset of the .results. However, it is notoriously old and well known in the art to do so (for instance to "1-10 of 25 results"). It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by doing so in order to fit the data on a standard computer screen in a legible way.

As to claim 17, it is noted that Sato et al show selecting a fixed number of keywords.

As to claims 18, it is noted that claimed subject matter is obvious over the claimed step of claim 17. Philips in view of Ishikawa et al and Sato et al show all elements of the claims except determining as keywords a predetermined percentage of the terms in the text. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify Philips using such a scheme in order to avoid searching terms with a very low IDF (for instance in cases where the text is about the size of the number of keywords chosen).

Alternatively, if it were determined that the claims were patentably distinct over claim 17, a species requirement would be necessary.

As to claim 19, Philips in view of Ishikawa et al and Sato et al inherently show comparing the IDF of each term in the description to a minimum threshold comprising the nth lowest IDF where n terms are used as keywords (it is noted that the threshold is not recited as fixed).

As to claims 20-22, 24, and 26, it is noted that Philips shows these description elements.

Additionally, it is noted that it is old and well known in the art to include any of the elements of claims 20-36 as appropriate for the type of sale and kind of items being sold. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by including such information in order to facilitate ease of purchase.

(10) Response to Argument

A. Rejection of claims 1, 56 and 57 under 35 U.S.C. 112, first paragraph

Applicant argues that claim 1 is enabled. The examiner respectfully disagrees. The claim recites "identifying as an auction offering an item unit that is a unit of the same item as the first unit" an auction where the search terms exceed a threshold. However, the specification does not enable that the auction found is actually for one of the same items.

Throughout the specification, the method used in finding other auctions or purchasing opportunities is described in terms of similarity. The terms "similar items", "degree of similarity", "likelihood of offering the same item" or "the same or similar" are used throughout the specification and fairly characterize the scope of the method. (see e.g., pg. 2, lines 16-17, 19; pg. 3, lines 18-20, 24-27, 30; pg. 6, line 27; pg. 9, line 10).

In examining and characterizing the results of the search, the specification never states that search results having a score above a certain threshold are identified as units of the same item as is contended by the Appellant. Rather, he states that they are more likely to be the same item.

The specification (pg. 9, lines 4-16) states:

> The purchasing opportunity scores can further be used to subset the found purchasing opportunities in a variety of ways. For example, the purchasing opportunity scores may be used to subset the list of found purchasing opportunities to include only (a) purchasing opportunities whose scores exceed an absolute threshold; (b) a fixed number of purchasing opportunities having the highest scores; or (c) a fixed percentage of the found purchasing

> opportunities having the highest scores. In terms of the example, to identify a group of similar purchasing opportunities, the facility preferably employs an absolute threshold of .05000000, thereby including purchasing opportunities 342197558 and 919822507 and excluding purchasing opportunity 219765112. In order to identify purchasing opportunities having a high likelihood of [emphasis added] offering the same item as the distinguished purchasing opportunity, the facility preferably applies an absolute threshold of .11000000, thereby including purchasing opportunity 919822507 and excluding purchasing opportunities 219765112 and 342197558.

The Appellant contemplates the possibility of a method which identifies certain auctions as having found units of the same item. However, he explicitly states that this is separate embodiment than the embodiment that is described and enabled in the specification.

On page 5, lines 8-14 of the Specification, Appellant states:

> The window further includes a "see similar auctions" button 223 for displaying information about auctions for similar items. The user may use this control to display information about similar auctions by clicking on the "see similar auctions" button 223. When the user clicks on button 223, the facility analyzes other auctions to identify similar ones. In additional embodiments, the facility can identify auctions for the same item, or purchasing opportunities of various types for the same item or similar items [emphasis added].

Because the specification describes only a method of finding similar items or those with a certain likelihood of being of the same type; because the specification explicitly states that a method which identifies auctions for the same item is a separate

embodiment; and because the specification never describes a method for the embodiment in which the same item is identified, the 112 1st rejection of claims 1, 56 and 57 is proper and should be affirmed.

B. Rejection of claims 1, 56 and 57 under 35 U.S.C. 112, second paragraph

Applicant argues that the use of the term "same" complies with the requirements of 35 U.S.C. 112, 2d. The examiner respectfully disagrees.

The 112 2d rejection is made in the alternative to the 112 1st rejection in response to Appellant's remarks during prosecution that an auction identified as for the same item could be for an item that is similar, but not the same. The Appellant argued during prosecution that "an auction that has an inverse document frequency value that exceeds a certain threshold can be identified as an auction 'offering an item that is the same as the first item.' This identification can occur even if the item is not exactly the same as the first item." (Remarks of 3/17/2003, pg. 16, last paragraph). Such a definition of "same" goes against the plain usage definition.

Applicant argues by way of example that a user might request to see more items of the same unit (in this case a Black and Decker 10 inch circular saw), and that "each available purchasing opportunity offers a unit of the same saw" (Appeal Brief, pg. 7, last two lines), and that this definition of same is consistent with the accepted meaning.

However, the method reports a list of purchasing opportunities, some which are for the same item (other opportunities to buy the circular saw), but others that are not (maybe a Black and Decker circular saw blade, 10 inch circular saw painted black, etc.). However, all of these auctions (both those offering the same item and those offering different items) are identified as auctions offering units of the same item. In identifying an auction for a different item as an auction for the same item, the term "same" is being used in a way that is antithetical to its plain meaning.

C. Rejection of claims 1, 56 and 57 under 35 U.S.C. 103(a) over Philips in view of Ishikawa (5,848,407) and Sato (6,212,517)

First the Appellant argues that the rejection is improper because it does not show performing the steps in the context of an auction (pg. 12, first full paragraph). The examiner respectfully disagrees. Philips, the base reference provides a context providing an item description of an item for sale. It does not show a sale via an auction, but Official Notice was properly taken that it is old and well known to sell at auction and that it would have been obvious to modify the reference to an auction context. Proper motivation was also provided. It is further noted that the Appellant does not dispute the taking of Official Notice.

Second, the Appellant argues that the rejection is improper because it does not show performing the steps in the context of an item description (pg. 12, second full paragraph). The examiner respectfully disagrees. Philips, the base reference provides explicitly provides an electronic document comprising a web pages having an item

description. When modified by Sato and Ishikawa, the search steps taught by those references are performed in the context of Philips, which is in the context of an item description.

Next, the Appellant appears to argue that the rejection is improper because it does not show "for each of the selected terms, conducting a search for auction in the group whose item descriptions contain the selected term" and "for each auction found in at least one of the conducted searches, determining which of the selected terms occur in the auction's item description" (pg. 12, final par. – pg. 13 first par.). The examiner respectfully disagrees.

To the extent that the Appellant means that they are not performed in the items description of auction context, the comments above are referenced.

Regarding the existence of the elements in the references, column 7, lines 27-30 read, "If the user selects the automatic search in step 340, then the user interface 400 responsively generates a query request by using a predetermined number, e.g., 3 of the related keywords with the highest degrees of importance". This shows performing the search with each of the selected terms, as claimed.

Regarding the step of determining which keywords occur, Ishikawa states, "a sum of the products calculated for all keywords is adopted as an estimated value of the particular hypertext documents" (col. 11, lines 35-38). In determining the value the keywords which occur are determined and the values in the document summed to reach a document value.

Next, the Appellant argues that Philips cannot be properly modified because it shows finding a similar product via a category break-down. However, the examiner respectfully disagrees.

First, the examiner does not necessarily agree that the reference only teaches that method. At the left hand side of the web page, near the top, there is a hyperlink marked "Find similar products". It is not clear whether pressing this button merely scrolls the page down to the categories, or whether it provides similar items via some other method.

Assuming that it does just reference the categories, the examiner believes that this is not a reason to avoid modification. Rather it is a reason to modify the reference. Having to manually search through the categories can be burdensome and an automated method would speed and ease that task. This reasoning is, in fact one of the motivation used in combining the references.

The Appellant further argues that the combination is improper because Philips provides only a single purchasing opportunity for a particular item, so additional units of the same item cannot be found. The examiner respectfully disagrees. First, identical electronic parts are often sold under more than one part number. (For example, the Nuvistor 6DS4 is the same item as the 6CW4, and an ECC83 is the same as 12AX7). Further, it is noted that Philips shows the same part available in different packaging and different order codes (see e.g., page 2, SA571D available as Order Codes 933772530602 and 933772530623).

Regarding Appellant's argument that motivation is lacking, it is noted that motivation was provided for all combinations.

D. Rejection of claims 2-36 under 35 U.S.C. 103(a) over Philips in view of Ishikawa (5,848,407) and Sato (6,212,517)

The Appellant argues that the rejection of claims 2-36 under 35 USC 103(a) is improper. The examiner respectfully disagrees.

Philips shows a plurality of purchasing opportunities (it is noted that auctions are not claimed, just purchasing opportunities) and it shows finding similar purchasing opportunities, but does not show the particular method of searching based on the purchasing opportunity item text.

Appellant argues that identifying "purchasing opportunities of a set containing one or more keywords" is not shown in the combination (p. 15, par. 2). The examiner respectfully disagrees.

Philips shows a set of purchasing opportunities, each an html file having descriptive text. Ishikawa shows searching a set of html files based on keywords and identifying those containing one or more keywords. Ishikawa shows performing the keyword search and that "a sum of the products calculated for all keywords is adopted as an estimated value of the particular hypertext document" (col. 11, lines 35-38). Since Philips shows the plurality of html documents which are purchasing opportunities, when Philips is modified by Ishikawa it shows searching a plurality of purchasing opportunities

and identifying a plurality of them containing one or more keywords (and ranking them by their importance via the keywords).

The Appellant further argues that Philips cannot be properly modified by Ishikawa and Sato because the difference between Philips method of identifying similar items and Ishikawa/Sato's method is too different.

The examiner respectfully disagrees. First, it is old and well known to have plural methods of finding similar items. For instance, eBay provides a category system so that a user while viewing an item can click on the category of the item and see many similar items. However, it also has a search function, so that if a user wishes to identify a similar item with greater specificity, he can use that function. In other words, the fact that a web site provides one method of finding similar items does not mean that it cannot be modified to provide another method, in addition to the first.

Second, the very difference presented – the fact that Philips requires manually viewing items in categories – is a motivation to make the modification. It is advantageous to modify the system to automatically provide similar opportunities without the need for manual intervention.

Next, the Appellant argues again argues that the combination fails to show "identifying purchasing opportunities of a set containing one or more keywords" (see response above), and argues that "displaying information about the identified purchasing opportunities " is not shown (p. 15, last par. for both arguments). As noted in the rejection, Ishikawa shows this element (see e.g., Fig. 12 showing the display of information about the results). As previously noted, since Ishikawa modifies Philips and

the html documents of Philips are purchasing opportunities, information regarding the identified purchasing opportunities is displayed.

Next, the Appellant argues that Ishikawa does not show scoring. Ishikawa shows that "a sum of the products calculated for all keywords is adopted as an estimated value of the particular hypertext documents and an importance degree for each " (col. 11, lines 35-38). It further shows that "ranking of the particular hypertext documents including the parent documents is determined according to the importance degrees of the particular hypertext documents". (col. 11, lines 43-46). Again, in the context of Philips, the document represent purchasing opportunities.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Steven B. McAllister

Conferees:

Alexander G. Kalinowski

Hyung S. Sough